

WYC:Imp 60304L 4/28/05

PATENT

REMARKS

After entry of the foregoing amendment, claims 1-5 are pending in the application.

Upon reviewing the Appeal Brief, the Examiner telephonically reopened prosecution, and indicated that claims 1-5 appeared to be allowable, subject to a Terminal Disclaimer over commonly-owned patent 6,324,573. The Examiner suggested that applicant pursue claims 6-13 in a continuation application.

Applicant's representative invited the Examiner to additionally consider the assignee's other patents relating to print-to-web linking technologies, including 6,681,028, 6,650,761, 6,408,331, and 6,286,036.

After conducting such review, the Examiner indicated that claims 1-5 appeared to be allowable subject to a Terminal Disclaimer over patents 6,324,573 and 6,286,036. The Examiner also required drawings illustrating the claimed subject matter.

Such a Terminal Disclaimer and drawings are submitted herewith. The specification has been amended to refer to the drawings. No new matter has been added.

(The filing of a Terminal Disclaimer is not intended as an admission, by the applicant or assignee, of the propriety of any rejection. Such disclaimer raises neither a presumption nor estoppel on the merits of a rejection. MPEP § 804.02.)

As requested by the Examiner, the specification has been reviewed to determine whether any of the references to related applications needs updating. Such a review has been conducted, and no further updates appear to be required. (Some references were earlier updated, in the April, 2004, Amendment.)

As discussed with the Examiner, an IDS is submitted herewith, citing two of assignee's above-mentioned patents (the others were earlier cited), together with third party patent: 5,665,951. A fee is paid, but no certification is believed to be required in view of the reopening of prosecution. (The Examiner indicated that such references were available to him, so no paper copy is provided in this FAX transmittal.)

The Examiner requested applicant to comment on why two items of art discovered in the Examiner's update search do not read on the claimed invention. Those items are "Watermark Building Image in Network Applications Market," Network World, Sept 13, 1993, vol. 10, No.

WYC:Imp 60304L 4/28/05

PATENT

37, p. 63, 2 pages; and "OLE-Based Image Management Software Cuts Time, Costs," Network World, Feb. 8, 1993, Vol. 10, No. 6, p. 6, 2 pages.

The "Watermark" referred to in these articles is understood to be the name of a company: Watermark Software, Inc. The articles are understood to relate to software offered by the company (*i.e.*, Watermark Discovery Edition) that allows images to be included in compound documents, using Microsoft's OLE technology.

Concerning OLE, the online encyclopedia Wikipedia explains:

***Object Linking and Embedding (OLE) is a Microsoft technology.***

*A distributed object system and protocol from Microsoft, also used on the Acorn Archimedes. OLE allows an editor to "farm out" part of a document to another editor and then reimport it. For example, a desktop publishing system might send some text to a word processor or a picture to a bitmap editor using OLE.*

*It was initially used primarily for copying and pasting data between different applications, especially using drag and drop, as well as for managing compound documents. It later evolved to become an architecture for software components known as the component object model (COM), and later DCOM.*

The Watermark Discovery Edition software is understood to permit addition of image objects (e.g., produced by scanning a newspaper clipping) into spreadsheets, email, etc. In email, for example, the image object would be represented as a thumbnail of the clipping. The user could double-click on the thumbnail in the email, and OLE would then trigger the Discovery Edition software to retrieve the full image from a remote server, and display it in a new window.

This Watermark brand software is not understood to teach or suggest the arrangement defined by claim 1. For example, there is no teaching or suggestion of a printed catalog. Nor is there any teaching or suggestion of electronically ordering an article depicted in a catalog.

Still further, the Watermark brand software is not understood to relate to steganography. As is familiar to artisans, and detailed in patent documents incorporated-by-reference into the present specification, steganography is the science of information hiding. It encompasses a great variety of techniques by which, *e.g.*, plural bits of digital data can be hidden in some other

WYC:Imp 60304L 4/28/05

PATENT

object, *without leaving human-apparent evidence of alteration or data representation.*<sup>1</sup> Thus, a product photograph in a catalog can be steganographically encoded to convey data related to that product.<sup>2</sup> This encoding can be detected and acted-upon by appropriate decoder systems, but is not generally perceptible to a human viewer of the image.<sup>3</sup>

In contrast, the Watermark-brand software inserts a *visible* thumbnail image – intended to be perceptible to a human viewer of the email, or spreadsheet, etc.

Accordingly, the two newly-cited references are not believed to teach or suggest the combination defined by claim 1, nor any of its dependent claims:

Favorable consideration and passage to issuance are solicited.

Date: April 28, 2005

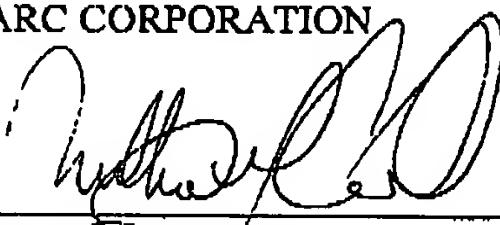
**CUSTOMER NUMBER 23735**

Phone: 503-469-4800  
FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By \_\_\_\_\_

  
William Y. Conwell  
Registration No. 31,943

<sup>1</sup> See, e.g., U.S. application 09/343,104 at page 4, lines 8-10. The '104 application was cited in the present specification at page 1, line 11, and incorporated by reference at page 1, line 12.

<sup>2</sup> See, e.g., specification, page 1, lines 18-19; page 2, lines 20-24.

<sup>3</sup> See, e.g., specification, page 2, lines 22-30.